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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,732	04/18/2002	Piero Baglioni	205,437	7375

7590 02/02/2005

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New York, NY 10017

EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,732

Applicant(s)

BAGLIONI ET AL.

Examiner

Cephia D. Toomer

Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 14-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no antecedent support in the specification for the language "wherein the emulsion does not include a microemulsion." Applicant never recites that the fuel composition of his invention may not be a microemulsion.

4. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Pyrolysis oil is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Throughout the specification applicant teaches that the pyrolysis oil (biooil) is essential to the invention.

Art Unit: 1714

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 26, 27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 is rejected because it does not provide proper antecedent support within the claim for pyrolysis liquid. Also, it is not clear which surfactants constitute "combinations of such surfactants and non-ionic surfactants having an HLB of from 4 to 18." Clarification and correction are required.

Claim 29 is rejected because there is no proper antecedent support within the claim for "the natural oil and/or the mineral oil."

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 14, 28, 30 and 31 rejected under 35 U.S.C. 102(b) as being anticipated by Hiroya (US 4,309,191).

Hiroya teaches a coal-oil mixture comprising coal dispersed in a hydrocarbon oil containing at least 5% olefinic hydrocarbons (see abstract). The mixture contains

Art Unit: 1714

surface-active agents such as polyethylene glycols (see col. 2, lines 56-67). The hydrocarbon oil (mineral oils) includes kerosene, gas oil, and fuel oil (see col. 3, lines 44-51; col. 5, lines 7-14). The olefinic hydrocarbons may be a pyrolysis oil (see col. 5, lines 21-31). Hiroya teaches that various emulsifiers (suggests a mixture) and 2 to 100 parts by volume of water per 100 parts hydrocarbon oil are used to prepare an emulsion (see col. 6, lines 50-67; claim 11). Hiroya teaches that the fuel is burnt using a rotary burner in an adiabatic horizontal cylindrical furnace (see Example 11).

Accordingly, Hiroya teaching all the limitations of the claims anticipates the claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 15-17, 20, 21, 23, 25, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroya (US 4,309,191) in view of Ikura (US 5,820,640)..

Hiroya has been discussed above. Hiroya teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Hiroya differs from the claims in that he does not specifically teach the HLB of the emulsifier (surfactant) or the claimed proportions of the emulsifier.

However, no unobviousness is seen in this difference because Ikura teaches that

Art Unit: 1714

emulsified fuels containing pyrolysis oil contain 0.5 to 5% by weight of emulsifiers having and HLB of from 4 to 18 (see col. 2, lines 1-21).

It would have been obvious to one of ordinary skill in the art to have prepared an emulsified fuel containing the claimed emulsifiers because Hiroya teaches that emulsified fuels contain these conventional surfactants to stabilize the fuel and Ikura teaches that these conventional surfactants have an HLB from 4 to 18 and are present in the composition in an amount from 0.5 to 5%.

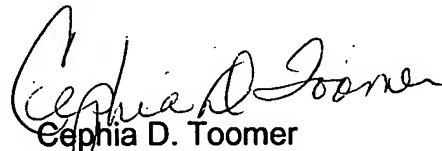
In the second aspect, Hiroya differs from the claims in that he does not specifically teach the same method steps of preparing the fuel. However, selection of any order of performing process steps or selection of any order of mixing ingredients is prima facie obvious in the absence of new or unexpected results. In re Gibson, 5 USPQ 230 (CCPA 1930).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cephia D. Toomer
Primary Examiner
Art Unit 1714

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